



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/541,443	03/31/2000	Rick Dedrick	042390.P7955	3695

7590

08/30/2002

Blakely Sokoloff Taylor & Zafman LLP
Donna Jo Coningsby
12400 Wilshire Boulevard
7th Floor
Los Angeles, CA 90025

EXAMINER

GREENE, DANIEL L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 08/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/541,443

Applicant(s)

DEDRICK ET AL.

Examiner

Daniel L. Greene

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11-21 and 27 is/are rejected.
- 7) ☒ Claim(s) 6-10, 22-26, 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

DETAILED ACTION

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Allowable Subject Matter

1. Claims 6-10 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 22-26&28 would be allowable if rewritten to establish the lending library as a separate organization from the borrowers and the applications are not resident on the borrower's computers.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 12-13, 16-19,21, are rejected under 35 U.S.C. 102(e) as being anticipated by Robert et al. US 4937863 [Robert'863].

As per Claim 1.

Robert'863 discloses an electronic asset lending library database containing a plurality of user accounts and at least one license for one of a plurality of unused electronic assets; Fig. 1, **10**

Robert'863 discloses an account manager to maintain the user accounts. Fig. 1, **10**

Robert'863 discloses an asset manager to maintain the licenses for the unused electronic assets. Fig. 1, **12**

Robert'863 discloses a loan manager to control the borrowing of the license for the unused electronic asset by a borrower having a one of the plurality of user accounts. Fig.1, **15**

As per Claim 2.

Robert'863 further discloses:

wherein the loan manager further controls the lending of the license for the unused electronic asset by a lender having another one of the plurality of user accounts.
Col. 4, lines 55-68.

As per Claim 3.

Robert'863 further discloses:

the account manager further maintains a subset of the plurality of user accounts as members of a one of a plurality of communities; Fig.1, **17** (group license table)

the asset manager further maintains ownership of the license by one of the communities; Fig. 1, **12** (license unit tables)

the loan manager restricts the borrowing of the license for the unused electronic asset to a borrower having a user account membership in the same community having ownership of the license. Col.4, lines 1-47.

As per Claim 12

Robert'863 discloses ;

managing a plurality of user accounts; Fig. 1, **10** (License Management Facility)

managing at least one license for one of a plurality of unused electronic assets;

Fig. 1, **14** (Licensed Program)

controlling the borrowing of the at least one license for the unused electronic asset by a borrower having one of the plurality of user accounts. Fig.1, **15** (Licensing Policy Module)

As per Claim 13.

Robert'863 discloses;

managing the plurality of user accounts includes associating each user account with a one of a plurality of communities; Col.3, lines 3-25.

managing the license includes associating the license with one of the plurality of communities and assigning the license to one of the plurality of user accounts. Col. 3, lines 40-68

As per Claim 16.

Robert'863 discloses;

creating a license for an unused electronic asset; Fig. 1, **14**

assigning the license to a first account having membership in one of a plurality of communities; Col.3, lines 40-68, Col.4, lines 1-68.

re-assigning the license from the first account to a second account if the second account is eligible to use the license and has membership in the same one of a plurality of communities as the first account. Col.3, lines 40-68, Col.4, lines 1-68.

As per Claim 17.

Robert'863 discloses;

communicating to a user of the second account information about the unused electronic asset, including whether the license is available, and wherein the license is reassigned to the second account only after receiving a request from the user. Col. 8, lines 4-20.

As per Claim 18.

Robert'863 discloses;

wherein the one of a plurality of communities is an organizational entity, including a division, department or team. Col.3, lines 3-25.

As per Claim 19.

Robert'863 discloses;

wherein the second account is eligible to use the license if the second account is listed on an access control list for the unused electronic asset. Col.3, lines 40-68, Col.4, lines 1-68.

As per Claim 21.

Robert'863 discloses;

wherein the second account is not eligible because not listed on the access control list for the unused electronic asset, but subsequently determined to be eligible in

response to an override request received from the user of the second account. Col. 14, lines 55-68, Col. 5, lines 1-10.

Claims 22-26, 28 rejected under 35 U.S.C. 102(e) as being anticipated by
Wyman US 5745879 [Wyman'879]

As per Claim 22.

generating a license and associated license restrictions for an unused electronic asset on a lending library server; Col. 6, lines 13-25.

displaying to a borrower the license and associated license restrictions on a lending library client; Col. 6, lines 39-68, Col. 7 lines 1-5.

receiving a borrower selection for the license and transferring the license to the borrower if eligible in accordance with the associated license restrictions; Col. 6, lines 1-35.

transmitting to the borrower instructions for the installation of the unused electronic asset in compliance with the transferred license on the lending library client. Col. 6, lines 1-35.

As per Claim 23.

Wyman'879 discloses wherein the lending library server and the lending library client are connected to a communications network. Fig. 1,21,22.

As per Claim 24.

Wyman'879 further discloses wherein the associated license restrictions require the borrower to belong to a community, the community being the same community to which the unused electronic asset belongs. Col.22, lines 62-68, Col. 23, lines 1-23.

As per Claim 25.

Wyman'879 further discloses wherein the associated license restrictions further require the borrower to be listed on an access control list associated with the unused electronic asset. Col. 24, lines 3-68.

As per Claim 26.

Wyman'879 further discloses wherein the community is an organizational entity, including a division, department or team. Col. 21, lines 47-68, Col. 22, lines 1-20.

As per Claim 28.

Wyman'879 further discloses wherein the data storage device is a CD-ROM or a DVD-ROM. Col. 9, lines 49-60.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5, 11,14-15,20,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robert et al. US 4937863 [Robert'863] and further in view of Ginter et al. US 5892900 [Ginter'900].

As per Claim 4.

Robert'863 discloses about a license database that contains the terms of the licenses for granting or denying use. Col.3, lines 52-60, but does not specifically disclose the incorporation of an access control lists.

Ginter'900 discloses an Access Control List (ACL) that provide "go/no-go" permissions in an analogous art for the purpose of providing full control over pre-defined and user-defined application events. Col. 85, lines 20-25.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to call Robert'863 license data-base, Ginter'900's Access Control List (ACL) because they both control the use of the various applications.

Robert'863 further discloses the asset manager further maintains an association between the access control list and the unused electronic asset; Col. 6, lines 9-30 and ; the loan manager further restricts the borrowing of the license for the unused electronic asset to a borrower having a user account listed in the access control list associated with the unused electronic asset. Col.5, lines 1-10.

As per Claim 5.

Robert'863 discloses wherein the access control list restriction is overridden in response to a request by a borrower not having a user account listed in the access control list associated with the unused electronic asset. Col. 4, lines 48-68, Col. 5, lines 1-10.

As per Claim 11.

Robert'863 discloses wherein a community is one of a plurality of types. Col.3, lines 3-25.

Robert'863 discloses the claimed invention except for the step of discloses wherein a community is one of a plurality of types of intra-organizational entities, including a project team, department, or division. It would have been an obvious matter of design choice to modify the teachings of Robert'863 to provide the step of discloses wherein a community is one of a plurality of types of intra-organizational entities, including a project team, department, or division. Since the applicant has not disclosed

Art Unit: 3621

that discloses wherein a community is one of a plurality of types of intra-organizational entities, including a project team, department, or division solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Robert'863 will perform the invention as claimed by the applicant with any method, means, or product to discloses wherein a community is one of a plurality of types of intra-organizational entities, including a project team, department, or division.

As per Claim 14.

Robert'863 shows lines of communications between the different functions of his invention but does not show displaying the plurality of unused electronic assets.

However, it is inherent in computer systems to display data.

Robert'863 further discloses reassigning the at least one license to a second one of the plurality of accounts in response to a selection of one of the plurality of unused electronic assets from the display by a borrower using the second one of the plurality of accounts. Col.4, lines 10-68.

As per Claim 15.

Robert'863 discloses;

managing the plurality of user accounts includes adding or deleting each user account into at least one of a plurality of access control lists or not; Fig. 1, **10** (License Management Facility)

managing the license includes associating the unused electronic asset with one of the plurality of access control lists; Col. 6, lines 9-30

controlling further includes restricting the borrowing to a borrower listed on the access control list to which the electronic asset is assigned. Col.5, lines 1-10.

As per Claim 20.

Robert'863 discloses action being taken when a request is made for program usage (Col.4., line 3) except for the step of wherein communication to the user of the second account is disabled if the second account is not a member of the same community as the first account. It would have been an obvious matter of design choice to modify the teachings of Robert'863 to provide the step of wherein communication to the user of the second account is disabled if the second account is not a member of the same community as the first account. Since the applicant has not disclosed that wherein communication to the user of the second account is disabled if the second account is not a member of the same community as the first account solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of

ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Robert'863 will perform the invention as claimed by the applicant with any method, means, or product to wherein communication to the user of the second account is disabled if the second account is not a member of the same community as the first account.

As per Claim 27.

Robert'863 discloses an electronic asset lending library database (Col.2, lines 63-68, Col. 4, lines 1-25) except for the step of wherein the electronic asset lending library database resides on a removable data storage device. It would have been an obvious matter of design choice to modify the teachings of Robert'863 to provide the step of wherein the electronic asset lending library database resides on a removable data storage device. Since the applicant has not disclosed that wherein the electronic asset lending library database resides on a removable data storage device solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Robert'863 will perform the invention as claimed by the applicant with any method, means, or product to wherein the electronic asset lending library database resides on a removable data storage device.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yamamura US 6023766. License Control License and Equipment.

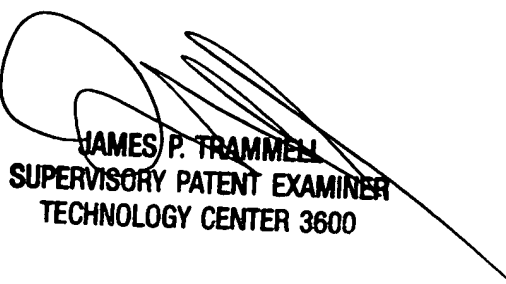
Frison et al. US 6049789. Pay per use.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703.306.5539. The examiner can normally be reached on M-Thurs. (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703.305.9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305-7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308-1113.

DLG
August 26, 2002


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600